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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,736	11/26/2003	Brian L. Mueller	02022US	7284
7590	03/24/2005		EXAMINER	
Rodel Holdings, Inc. Suite 1300 1105 North Market Street Wilmington, DE 19899			MARCHESCHI, MICHAEL A	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/722,736	MUELLER ET AL.
	Examiner Michael A Marcheschi	Art Unit 1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 January 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shemo et al. (140) alone or in view of EP 1 223 609 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Streinz et al. (686) in view of Shemo et al. (140) and EP 1 223 609 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-2, 4-7 and 9-10 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nishimoto et al. (305).

Applicant's arguments filed 1/11/05 have been fully considered but they are not persuasive.

With respect to the composition, applicants argue that none of the primary references teach a composition for polishing silica relative to silicon nitride. Although this might be the case with respect to Shemo et al. and Streinz et al., applicants are reminded that the preamble limitation "for polishing..." is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q.

64. In view of this, the use has no bearing on the composition and the composition stands alone in view of its patentability. Any further arguments with respect to the use of the composition are therefore moot and no further comment is necessary. Applicants appear to criticize the

examiners position of the composition and argue the use limitation and this is not proper in view of the case law defined above. Although not argued, the pH limitation of the amended claims is clearly encompassed by Streinz et al. (pH of 1-5) and Nishimoto et al. (pH of 7). In addition, Nishimoto et al. implies that other pH values can be applied. The statement "if the pH is lower than 7" coupled with the limitation "some cases" as defined in that statement does not exclude a pH lower than 7. If it did it is the examiner position that the above statement would have recited "all cases". In addition, the pH defined by the reference is a preferable limitation and as is well known "**a reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments**" See *In re Van Marter*, 144 USPQ 421. Although Shemo et al. does not literally define a pH, since all compositions must have a pH, it is the examiners position that the absence of any pH constitutes an implication of a broad pH range as long as the composition can be used in the manner defined. In view of this, it is the examiners position that the broad pH of this reference would encompass the claimed pH absent evidence to the contrary.

With respect to Nishimoto et al., the reference column 11, lines 6-7 state that the composition is used to polish a silicon **type** film and a silicon oxide film and section [0175] defined that the silicon **type** film can be silicon nitride, thus these two teaching coupled together teach polishing silicon nitride relative to silicon oxide

Applicants also appear to argue the results show in table 2. The result defined therein is compared to a composition that does not contain TMAH (ammonium compound) but all of the references use this component. In view of this how would this shown unexpected results over references that explicitly contain this material? In addition, applicants results are insufficient to

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show unexpected results over the broad claimed range and the broad ammonium compounds of the claims. The tables are only limited to a specific quaternary compound (i.e. TMAH) and not any other material that is encompassed by the broad claimed compounds and the tables only define a few specific values which would not provide criticality for the entire claimed range (a sufficient amount of comparative evidence has not been provided to establish unexpected results).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Michael A Marcheschi*

Primary Examiner

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3/05

MM